



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/697,340	10/24/2000	Mary E. Brunkow	240083.501D4	3183

500 7590 09/30/2002

SEED INTELLECTUAL PROPERTY LAW GROUP PLLC
701 FIFTH AVE
SUITE 6300
SEATTLE, WA 98104-7092

EXAMINER

BELYAVSKYI, MICHAEL A

ART UNIT PAPER NUMBER

1644

DATE MAILED: 09/30/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/697,340

Applicant(s)

BRUNKOW ET AL.

Examiner

Michail A Belyavskyi

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2002 and 28 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 1644

DETAILED ACTION

1. The Art Unit location and the examiner of your application in the PTO have changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Michail Belyavskyi, Art Unit 1644, Technology Center 1600.

Claims 20-23 are pending.

2. Applicant's election of Group IV, Claims 20-23 Paper No. 7 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 20-23 are under consideration in the instant application.

3. The specification on page 1, line 5 should be amended to reflect the status of the parent application 09/372,668.

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention *to which the claims are directed*.

5. The Abstract of the Disclosure is objected to because it does not adequately describe the claimed invention. Correction is required. See MPEP 608.01(b).

6. Formal drawings have been submitted which fail to comply with 37 CFR 1.84. Please see the enclosed form PTO-948.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

A. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the "Notice of Allowability."

Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing

Art Unit: 1644

the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

B. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.185(a). Failure to take corrective action within the set (or extended) period will result in ABANDONMENT of the application.

7. Applicant's amendment, filed 10/25/00 (Paper No. 3), notes that an IDS was submitted with the prior application 09/372,668. However the references cited in said parent application cannot be found. Applicant is invited to resubmit such references to complete the instant file. The examiner apologizes for any inconvenience to applicant for having to resubmit such documents.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 20-23 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 is indefinite and ambiguous in the recitation of "Fkh^{sf}" in the first line. The use of "Fkh^{sf}" as the sole means of identifying the claimed gene product without providing SEQ ID NO renders the claim indefinite, because "Fkh^{sf}" is merely a laboratory designation which does not clearly define the claimed product since different laboratories may use the same laboratory designations to define completely different products.

Art Unit: 1644

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 20-23 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method of detecting the presence of Fkh^{sf} encoded by amino acid sequence of SEQ ID NO:2 or 4 using anti- Fkh^{sf} antibody or an antibody fragment that can bind to Fkh^{sf} encoded by amino acid sequence of SEQ ID NO:2 or 4 , an does not reasonably provide enablement for a method of detecting the presence of any Fkh^{sf} or any mutant form thereof. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

The claims as written encompass the genus of antibodies that can specifically bind polypeptides wherein such polypeptides have numerous differences in amino acid sequences at different position that were not disclosed (mutant form of Fkh^{sf}) including numerous differences in linear and conformational epitopes.

Factors to be considered in determining whether undue experimentation is required to practice the claimed invention are summarized *In re Wands* (858 F2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988)). The factors most relevant to this rejection are the scope of the claim, the amount of direction or guidance provided, the lack of sufficient working examples, the unpredictability in the art and the amount of experimentation required to enable one of skill in the art to practice the claimed invention.

There is insufficient guidance and direction as to how to make an antibody that can detect the presence of any Fkh^{sf} or any mutant form thereof and use it in a method of detecting the presence of any Fkh^{sf} or any mutant form thereof.

Claim 20 requires antibody to bind to different polypeptides. However, the present specification fails to provide sufficient disclosure of mutant forms of Fkh^{sf} encoded by SEQ ID NO: 2 or 4 that maintain the structural and functional properties of the Fkh^{sf} encoded by SEQ ID NO: 2 or 4. There is no description of mutation sites that exist in nature and there is no description of how the structure of mutant form relates to the structure and function of Fkh^{sf} encoded by SEQ ID NO: 2 or 4. Moreover, the specification disclosed only variant of Fkh^{sf} encoded by SEQ ID NO: 2 or 4 and only anti- Fkh^{sf} antibody or an antibody fragment that can bind to Fkh^{sf} encoded by amino acid sequence of SEQ ID NO:2 or 4. The common attributes of the Fkh^{sf} are not described. The specification does not provide sufficient guidance as to which of the amino

Art Unit: 1644

acids may be changed while Fkh^{sf} functional is retained. In addition, the term "mutant form" encompass any substitution, deletion or insertion of amino acid of SEQ ID NO:2 or 4 that will affect the structural and functional properties of the Fkh^{sf} encoded by SEQ ID NO: 2 or 4.

Colman *et al.*, in *Research in Immunology* (145(1):33-36, 1994) teach single amino acid changes in an antigen can effectively abolish antibody antigen binding. Abaza *et al.*, in *Journal of Protein Chemistry* (11(5):433-444, 1992) teach that single amino acid substitutions outside the antigenic site on a protein effect antibody binding. Further, Lederman *et al* in *Molecular Immunology* (28:1171-1181, 1991) disclose that a single amino acid substitution in a common allele ablates binding of a monoclonal antibody (see entire document). Additionally, Li *et al* in *PNAS* (77:3211-3214, 1980) disclose that dissociation of immunoreactivity from other biological activities when constructing analogs (see entire document). Moreover, Applicant himself acknowledge that the function of the invention by discovery that a mutation in the gene which encodes Fkh^{sf} that results in rare condition (scurfy) was "unexpected" (page 9, lines 29-31, of the specification as filed). As such, the invention must be considered unpredictable.

Because of this lack of guidance, an undue experimentation would be required to determine which modifications would be acceptable to retain occluding structural and functional activity, and the fact that the relationship between the sequence of a protein/peptide and its tertiary structure (i.e. its activity) are not well understood and are not predictable (e.g. see Ngo *et al* in the Protein Folding problem and Tertiary Structure prediction, 1994, Merz *et al.*, (ed), Birkhauser, Boston, MA, pp.433 and 492-495), it would require an undue amount of experimentation for on of skill in the art to arrive at the claimed method of detecting the presence of any Fkh^{sf} or any mutant form thereof using anti- Fkh^{sf} antibody, encompassed by the claimed invention.

The scope of the claimed method of detecting the presence of any Fkh^{sf} or any mutant form thereof is not commensurate with the enablement provided by the disclosure a method of detecting the presence of Fkh^{sf} encoded by amino acid sequence of SEQ ID NO:2 or 4 using anti- Fkh^{sf} antibody or an antibody fragment that can bind to Fkh^{sf} encoded by amino acid sequence of SEQ ID NO:2 or 4 with regard to the extremely large number of amino acid sequences broadly encompassed by the claimed invention. Since the amino acid sequence of a protein determines its structural and functional properties, predictability of which changes can be tolerated in a protein's or peptide's amino acid sequence, and, in turn, nucleic acid sequence and still retain similar biological activity or structural specificity requires a knowledge of and guidance with regard to which amino acids in the protein's sequence, if any, are tolerant of modification and which are conserved (i.e. expectedly intolerant to modification), and detailed knowledge of the ways in which the protein's structure relates to its function. However, the problem of predicting protein structure from mere sequence data of a limited number of proteins and in turn utilizing predicted structural determinations to ascertain functional aspects of the protein and finally what changes can be tolerated with respect thereto is extremely complex and well outside the realm of routine experimentation.

Art Unit: 1644

Thus, Applicant has not provided sufficient guidance to enable one skill in the art to use claimed method of detecting the presence of any Fkh^{sf} or any mutant form thereof in manner reasonably correlated with the scope of the claims. The scope of the claims must bear a reasonable correlation with the scope of enablement. *In re Fisher*, 166 USPQ 18 indicates that the more unpredictable an area is, the more specific enablement is necessary in order to satisfy the statute.

In view of the quantity of experimentation necessary, the unpredictability of the art, the lack of sufficient guidance in the specification, the limited working examples, and the limited amount of direction provided given the breadth of the claims, it would take undue trials and errors to practice the claimed invention.

11. Claims 20-23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant is in possession of a method of detecting the presence of Fkh^{sf} encoded by amino acid sequence of SEQ ID NO:2 or 4 using anti- Fkh^{sf} antibody or an antibody fragment that can bind to Fkh^{sf} encoded by amino acid sequence of SEQ ID NO:2 or 4 .

Applicant is not in possession of a method of detecting the presence of any Fkh^{sf} or any mutant form thereof in a biological sample.

Applicant has disclosed a limited number of species; therefore, the skilled artisan cannot envision all the contemplated amino acid sequence possibilities recited in the instant claims. Consequently, conception in either case cannot be achieved until a representative description of the structural and functional properties of the claimed invention has occurred, regardless of the complexity or simplicity of the method. Adequate written description requires more than a mere statement that it is part of the invention. The sequences themselves are required. See Fiers v. Revel, 25 USPQ2d 1601, 1606 (CAFC 1993).

A description of a genus of polypeptide sequences may be achieved by means of a recitation of a representative number of polypeptide sequences, defined by amino acid sequence, falling within

Art Unit: 1644

the scope of the genus, or of a recitation of structural features common to the genus, which features constitute a substantial portion of the genus. *Regents of the University of California v. Eli Lilly & Co.*, 119 F.3d 1559, 1569, 43 USPQ2d 1398, 1406 (Fed. Cir. 1997).

Vas-Cath Inc. v. Mahurkar, 19 USPQ2d 1111, makes clear that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the written description inquiry, whatever is now claimed." (See page 1117.) The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See *Vas-Cath* at page 1116.). Consequently, Applicant was not in possession of the instant claimed invention. See *University of California v. Eli Lilly and Co.* 43 USPQ2d 1398.

Applicant is directed to the Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, ¶ 1 "Written Description" Requirement, Federal Register, Vol. 66, No. 4, pages 1099-1111, Friday January 5, 2001.


12. No claim is allowed.

13. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which Applicant may become aware in the specification.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michail Belyavskiy whose telephone number is (703) 308-4232. The examiner can normally be reached Monday through Friday from 9:00 AM to 5:30 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

Michail Belyavskiy, Ph.D.
Patent Examiner
Technology Center 1600
September 30, 2002


CHRISTINA CHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600